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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,969	12/05/2002	Janet Elizabeth Opel	Rev 98-19	3818

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/065,969	OPEL ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 7 and 15 are objected to because of the following informalities: In claim 7, there should be no gap proceeding the claim sentence to ensure that there is no other claim limitation that are omitted. In claim 15, line 7, there should be a semicolon following the term "chain alkyl" instead of the period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7, and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "moderate to extensive branching". The claim is vague and indefinite as the metes and bounds of the scope of the limitation is not clear.

Claim 7 recites the limitation "the sterol" in claim 1. There is insufficient antecedent basis for this limitation in the claim. The claim is also rejected because the structure is incomplete, for the absence of a hydroxyl group in the drawing.

Claim 16 recites the limitation "methyl" in claim 15. There is insufficient antecedent basis for this limitation in the claim. R1 according to claim 15 is in the range of C4-20.

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In claim 17, it is not clear whether the claim requires both octyldodecyl alcohol and isostearyl alcohol, or one of the two alcohols.

The remaining claim, claim 18, is rejected as depending on the indefinite claim, claim 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacks et al. (US 5690918) in view of Croda (Personal Care, Super Sterol Ester) and Mercado et al. (US 4996044) ("Mercado").

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Claimed invention is a composition comprising 1) 0.5-30 % of a stick structuring agent which is a solid or semi-solid at room temperature and has a melting point of 34-38 C; 2) 10-90 % of a nonvolatile oil which is selected from the group consisting of triisostearyl citrate, trioctyldodecyl citrate and mixture thereof; 3) 1-30 % of a wax comprising a fatty alcohol; and 4) 0.1-25 % of particulate matter having a particle size of 0.5 to 200 microns.

Croda teaches a lipstick formulation comprising 1) 7.39 % of C10-30 cheolesterol/lanosterol esters; 33.63 % of Oleyl alcohol; 7.712 % of pigments. See Technical Data, p. 5. See p. 2, second par. The melting point of Super Sterol Ester is said to be 30-38 C. The reference teaches that Super Sterol Ester “produces elegant sticks, proving their skin feel and given them a creamy pay-off”, and exhibits excellent spreading ability and provides good adhesion properties to these anhydrous systems”. See p. 2, second par. The ester is also said to be tasteless, clear, and “considered the ingredient of choice for lipsticks”. See *Id.*

Croda fails to teach the claimed volatile oil.

Jacks teaches lipstick formulations comprising 1 % of trioctyldodecyl citrate. See Examples. The reference teaches that, to provide “desirable feel, spreadability, gloss and other desirable characteristics, a mixture of low viscosity and high viscosity oil soluble liquids are used. High viscosity oils include triesters of citric acids. See col. 5, line 66 – col. 6, line 9. Example formulations also comprise cyclomethicone and acrylate copolymer. See instant claims 13 and 19. Polyethylene wax is also taught in col. 5, lines 35 – 40. While cetyl alcohol and

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oleyl alcohol are taught, the reference teaches these as low viscosity oils. See col. 5, lines 49 – 65.

Mercado teaches that cetyl alcohol and stearyl alcohol are wax feel enhancers and structure strengtheners useful for lipstick formulation. See col. 4, lines 8 – 18.

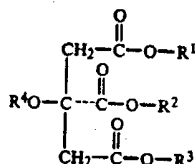
It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Croda by adding the triester of citric acid as motivated by Jacks because of the expectation of successfully producing a lipstick composition which provides good skin feel, spreading ability and gloss when applied. Selecting cetyl alcohol wax to make the composition of the combined references would have been also obvious in view of Mercado because of the expectation of successfully enhancing the feel of and strengthen the structure of the composition.

Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croda, Jacks, and Mercado as applied to claims 1-16, 18, and 19 above, and further in view of Natraj et al. (US 5244665) ("Natraj") and Clement (US 5118507).

While the combined references fail to teach "triisostearyl citrate", Jacks teaches, "Other triesters of citric acid, such as disclosed in US Pat. No. 5244665" may be used in place of some or all of trioctyldodecyl citrate. See col. 6, lines 2 – 6.

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The U.S. Pat. No. 5244665 is issued to Natraj et al., and teaches triester of citric acid having the structure



where R1, R2, and R3 each independently represent a branched or unbranched alkyl, alkenyl, aryl, alkyl-aryl or arylalkyl group, each said group being optionally substituted and having from 1 to 18 carbon atoms, R4 representing H2 or a branched or unbranched saturated or unsaturated acyl, alkyl, aryl, alkyl-aryl or alkylaryl group, each said group being optionally substituted and having from 1 to 18 carbon atoms. Thus triisostearyl citrate limitation is met. The reference teaches that the triesters are used to treat photodamaged and/or or hyperpigmented skin, and to slow down aging process generally. See col. 2, lines 3 – 11.

Clement teaches that a combination of volatile silicone fluid, a non-volatile silicone gum and a C16-C22 fatty acid ester of citric acid produces a cosmetically desirable tacky feeling. Triisostearyl citrate is particularly demonstrated in the reference. See Examples.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the trioctyldodecyl citrate with triisostearyl citrate as motivated by Natraj and Clement because 1) all the references are in cosmetic art know to the routineer; 2) Jacks teaches that triisostearyl citrate is within the scope of the suitable citric acid triesters for the lipstick formulation; and 3)

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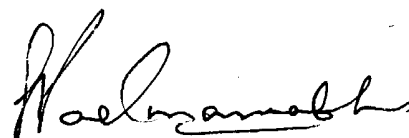
Clement teaches that trioctyldodecyl citrate produces a cosmetically desirable properties when combined with volatile and nonvolatile silicone compounds which are also used in Jacks formulations (cyclomethicone, silicone gum). In combining the teachings of these references, the routineer would have had a reasonable expectation of successfully producing a lipstick composition, which produces a cosmetically desirable tacky feeling.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER